

### **Remarks**

Claims 19-23 are pending in this application. Claims 24-31 are newly added claims. The Applicants have canceled claims 1-18 without prejudice.

The Office action dated September 8, 2005 ["Office action"], rejects claims 19-23 as being unpatentable over U.S. Patent No. 5,729,280 to Inoue et al. ["Inoue"] in view of U.S. Patent No. 6,363,440 to Stepp et al. ["Stepp"] in further view of U.S. Patent No. 5,517,257 to Dunn et al. ["Dunn"].

Applicants disagree with the rejections given and the Examiner's characterizations. Reconsideration of the application is respectfully requested in view of the foregoing amendments and following remarks.

#### **1) Supplemental IDS**

Applicants thank the Examiner for providing initialed Form 1449's for the Information Disclosure Statements [IDS's] filed on August 24, 2005 in the application. Applicants also thank the Examiner for pointing out that six references were not available for viewing, in the IDS Filed October 2, 2001, and received by the USPTO on October 17, 2001. These six references were faxed to the Examiner on July 5, 2005 in a Supplemental IDS. Furthermore, for convenience' sake, a copy of the form 1449 sent with the references is included with this amendment. Applicants respectfully request that the Examiner consider these references.

#### **2) With the goal of reaching a shared understanding of the disclosure of Inoue, Stepp, and Dunn, the Applicants respectfully make the following observations.**

##### **A) Inoue**

Inoue describes a system where a single program is broadcast at intervals on a sequence of channels. [Inoue, Fig. 2A, 5:61-6:9.] In the illustrated example, "broadcasting of the [single] program commences once every seventeen minutes and continues consecutively." [Inoue, 6:4-5.] Therefore, only enough disk space is needed (in the example) to store the offset between intervals--seventeen minutes of processed video signals. [See Inoue, 6:7-9.] At any rate, if a user pauses a video, the video must be stored in a buffer for a time period only as long as the interval period.

**B) Stepp**

Stepp describes a system that allows a user to watch (or record) an entire traditional broadcast media program from the beginning even if the user begins watching the program at some point in the middle. [Stepp, 1:12-27, Abstract.] If the broadcast media program that is being recorded lasts for two hours, then the system in Stepp must record and store the entire two hours worth of video.

**C) Dunn**

Dunn describes a system that stores movies digitally, and where “each video data stream can be accessed through pointers to the particular memory location.” [Dunn, 4:31-35.] Simultaneous users can access the video as the video is transmitted “by slightly staggered pointers to the same video data stream beginning at the same memory location.” [Dunn, 4:37-46.]

**3. The combination of Inoue, Stepp, and Dunn set forth by the Examiner to reject claims 19-23 is improper.**

In rejecting claims 19-23, the Examiner appears to incorporate Stepp’s buffering of potentially an entire broadcast program into the near-video-on-demand system of Inoue, which is only required to store an amount of video equal to the offset between subsequent video broadcasts. [Office action of September 8, 2005 at 2.] Applicant believes this combination is improper because the combined teachings of Inoue and Stepp would not have suggested such a combination to one of ordinary skill in the art. [See M.P.E.P. 2143.01.]

If, assuming for the sake of argument, one of ordinary skill incorporated Stepp’s compression to the known maximum buffer size found in Inoue, the result would not have been the combination set forth by the Examiner. Rather, the combined teachings of Inoue and Stepp *teach away* from the combination set forth by the Examiner. One of ordinary skill in the art would not have been motivated to modify Inoue with Stepp as the Examiner has done. [See M.P.E.P. 2143.02.]

Inoue describes a system that only requires a known amount of video be stored—the offset between subsequent program broadcasts [Inoue, Figs. 2A, 3A, 4A, 6A, and 6B], plus some extra time for previews and the like. [Inoue 11:44-53.] The Examiner, however, appears to apply the compression of Stepp to the system of Inoue, which needs only fixed-length video

storage “to increase the effective capacity of the storage device.” [Office action at 3.] However, not only does Inoue provide no motivation to increase its storage space, but it directly teaches away from Stepp, which requires that an entire broadcast program be stored. [Stepp, 1:12-27.]

Because the combination of Inoue and Stepp is improper, the combination of Inoue, Stepp, and Dunn is also improper for, *inter alia*, the same reasons. For at least these reasons, claims 19, 22, and 23 are patentable. As claims 20-21 and 24-31 depend from claim 19, they, too, should be allowed. Such action is respectfully requested.

**4. The cited art fails to teach or suggest several limitations in Claims 19, 22, and 23.**

Claims 19, 22, and 23 are also separately patentable as Inoue, Stepp, and Dunn, taken separately or in combination, fail to teach or suggest at least one limitation of each of amended claims 19, 22, and 23.

The Examiner admits that Inoue fails to teach or suggest “displaying a user interface to control the program display, the user interface comprising a delay control and a resume control,...receiving actuation of the delay control via the user interface, and in response to the delay control actuation; persisting the user interface on screen with the resume control highlighted” as disclosed in claims 19, 22, and 23. However, the Examiner then asserts that Dunn teaches that “the interface 100 with play/resume control highlighted is proved on screen when the movie is paused.” [See Office action of September 8, 2005 at 3.] The assertion that Dunn discloses highlighting the play/resume control is incorrect.

Dunn describes a system where a pause button [Dunn, FIG. 5 at 102] is replaced with a play button [Dunn, FIG. 6 at 102] when a video is paused. The video controller is otherwise unchanged. The flow chart of figure 8 in Dunn shows exactly the same actions occurring when the movie is played or paused/stopped. When the play button is selected, box 208 is selected. Box 208 states “Display Icon with “pause”, “stop”, “ff”, and “rewind”. When the pause button is selected, box 210 is selected. Box 210 states the same language as box 208: “Display Icon with “pause”, “stop”, “ff”, and “rewind”. [Dunn, FIG. 8.] Even assuming this is a mistake, it points to the lack of a difference between the invention when at the “play” state and when at the “pause” state. At any rate, hiding a play button and displaying a pause button while otherwise not changing the display, as is taught in Dunn is different than, and teaches away from,

“persisting the user interface on screen with the resume control highlighted” as taught in claims 19, 22, and 23.

Furthermore, Dunn does not teach or suggest “persisting the user interface on screen” as taught in claims 19, 22, and 23. Nowhere in the language of Dunn cited by the Examiner to assert this (Dunn, FIGs. 6 and 8, 7:63-8:13; 6:36-39) is found an indication of “persisting the user interface on screen.” Dunn, rather, teaches “[i]f the viewer wished to pause or stop the movie, or skip through certain pans using rewind or fast forward functions, the viewer presses any button on the remote control handset 40 to call up the icon.” [Dunn, 7:63-66.] The idea of a disappearing icon (because it must be called up) as taught in Dunn teaches directly away from “persisting the user interface on screen” as taught in claims 19, 22, and 23.

For at least these reasons, claims 19, 22, and 23 are patentable. As claims 20-21 and 24-31 depend from claim 19, they, too, should be allowed. Such action is respectfully requested.

### **CONCLUSION**

Claims 19-31 should be allowable. Such action is respectfully requested.

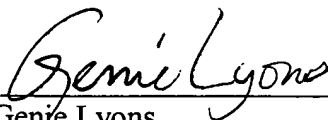
### **REQUEST FOR AN INTERVIEW**

If the Examiner finds that the amendment does not make the application allowable over the cited art, the Examiner is formally requested to contact the undersigned patent agent at (503) 595-8560 prior to the issuance of the next communication to arrange a telephonic interview. It is believed that a brief discussion of the merits of the present application will allow the application to be passed to issue. Applicant submits the foregoing remarks so that the Examiner may fully evaluate Applicant's position, thereby enabling the interview to be more productive.

This request is being submitted under M.P.E.P. § 713.01, which indicates that an interview may be arranged in advance by a written request.

Respectfully submitted,

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| <b>Examiner Name</b>          | Vu, Ngoc K.   |

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DATE  
CONSIDERED:

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